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Customer Number

Patent
Case No.: 58028US006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: KAWATE, KOHICHIRO

Application No.: 10/517,670

Confirmation No.: 1922

Filed: June 23, 2003

Title: HEAT CURABLE ADHESIVE COMPOSITION, ARTICLE, SEMICONDUCTOR
APPARATUS AND METHOD

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants file this Response in reply to an outstanding Office Action dated March 6, 2007. Claims 1-8 are currently pending in the application. Applicants file this Response concurrently with a request for a one month extension of time. The Examiner restricts claims 1-4 and 6-8 under 35 U.S.C. §§ 121 & 372 into the following Groups:

- I. Claim 1, said to be drawn to a heat curable adhesive composition;
- II. Claim 2, said to be drawn to a process for preparing the adhesive;
- III. Claims 3 and 6, said to be drawn to an adhesive article;
- IV. Claims 4 and 7, said to be drawn to a semiconductor apparatus; and
- V. Claim 8, said to be drawn to a process for preparing a semiconductor apparatus.

Election

In response to the Examiner's restriction requirement, Applicants elect Group I (claim 1) with traverse. The Examiner issues the five-way restriction requirement premised on the allegation that the restricted groups "do not relate to a single general inventive concept" under PCT Rule 13.2. Applicants respectfully traverse the restriction. The Examiner makes no assertion or allegation that the claims relate to independently patentable subject matter or patentably distinct inventive embodiments. The Examiner also fails to assert or allege that the searching and examination of two or more of the restricted groups together represents an undue burden. Absent these circumstances, Applicants submit that restriction of the claims is inappropriate. Applicants therefore respectfully request reconsideration and withdrawal or modification of the restriction requirement. In the alternative, Applicants reserve the right to request recombination and rejoinder of one or more non-elected claims upon the identification of allowable subject matter during examination of the elected claim.

Status of Dependent Claim 5

Applicants note the omission of dependent claim 5 from the restriction requirement. Applicants presume that, given the Examiner's groupings, claim 5 (which depends from claim 4) would be included in Group IV. Claim 5 would not therefore be considered elected. Applicants respectfully request clarification of the status of claim 5 in the next Office Action.

Claim Listing


In response to the Examiner's request, Applicants attach to this Response a clear and legible listing of the pending claims. Applicants offer an amendment to dependent claim 5 to correct a minor typographical error.

Conclusion

Applicants elect Group I for examination and do so with traverse. Applicants respectfully request continued timely prosecution of the application. The Examiner is invited to contact Applicants undersigned attorney at the indicated telephone number with questions that can be resolved with a simple teleconference.

Respectfully submitted,

April 12, 2007
Date

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